

REMARKS

This is a complete response to the outstanding final Office Action mailed February 5, 2007. Claims 33-43 have been canceled herein. Upon entry of the enclosed claim amendments, claims 21-32 and 44 remain pending in the present application.

The Applicant traverses all of the objections and rejections of the Office Action. Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

I. Response to new claim objections under 35 USC 112 2nd paragraph

A. Claim 32

Applicant has canceled claim 32 herein. The rejection raised by the Examiner is considered moot.

B. Claim 21

The Office has rejected claim 21 for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention under 35 U.S.C. § 112 second paragraph.

The Examination lacks the evidence, facts, or findings sufficient to establish a *prima face* case of being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention under 35 U.S.C. § 112 second paragraph. "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." See M.P.E.P. 2173.02. "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action." See M.P.E.P. 2173.02.

The Examiner's analysis is that one cannot ascertain how a layer that is a component of a region would contact the upper

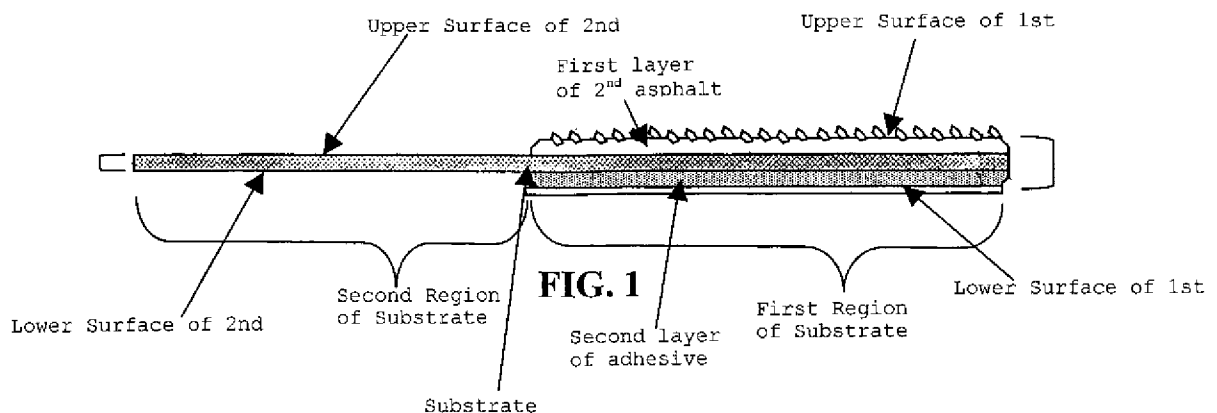
surface of that region, since the only thing that would contact that region would be something that is not a component of that region. This analysis is with regard to the "upper surface" and "lower surface" recitation. The analysis relays on a narrow definition of the term "surface", for example, "the external or superficial aspect of something". See Merriam Webster's Collegiate Dictionary Tenth Edition, 1993. The logic follows that the external aspect of something can only contact an object external to the region. Therefore, an object internal to the region could not contact the external surface.

The analysis ignores other equally understood definitions of surface, for example, "the exterior or upper boundary of an object or body." See Merriam Webster's Collegiate Dictionary Tenth Edition, 1993. Under this definition an upper boundary of an object logically could be in contact with an object that is internal to the region as well as another object external to the region could also be in contact with the upper boundary.

"Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." See M.P.E.P. 2173.02. "Examiners are encouraged to suggest claim language to applicants

to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." See M.P.E.P. 2173.02.

Applicant has provided claim language that particularly points out and distinctly defines the metes and bounds of the subject matter. Applicant has provided language that defines the metes and bounds of the claimed subject matter and is supported by the claim language and the specification. For example, Applicant has provided a reading of the claim language on the original filed figure 1 as shown below.



If the Office intends to make a 35 U.S.C. 112, second paragraph, the Office is required to put on the record and provide clear evidence as to why Applicant's claim language from the point of reference of the regions and their boundaries does not define

the metes and bounds of the claimed subject matter.

III. Response to claim rejections based on anticipation

In the Office Action, claims 21, 22, 24, 29, 32-34, 36, 41, and 44 have been preliminarily rejected as anticipated under 35 U.S.C. § 102(b). Specifically claims 21, 22, 24, 29, 32-34, 36, 41, and 44 have been rejected under 35 U.S.C. § 102(b) by U.S. Patent No. 5,096,759 to Simpson et al. (hereinafter, "Simpson").

A. Claim 21

Independent claim 21 reads:

A **rolled roofing material** comprising:

 a **substrate saturated** with a first asphalt composition, said substrate including:

 a first region having a first layer of a second asphalt composition contacting an upper surface of said first region and a second layer of an adhesive composition contacting a lower surface of said first region; and

 a second region disposed along at least a first edge of said substrate, said second region having an upper and a lower surface substantially free of said first and said second asphalt compositions;

granules contacting an outer surface of said first layer; and

 a **release backing** disposed over a bottom surface of said second layer.

(**Emphasis Added**)

The Applicant respectfully submits that Simpson fails to

disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Applicant's claim 21 recites, a rolled roofing material comprising: a substrate, granules, and a release backing. The Office references, Simpson disclosure of multiple roofing materials in Figures 10 and 11. Simpson's applied roofing system includes multiple layers of roofing material including one or more a sheets of roofing material (element 10) and as referenced by the Office two layers of underlayment (element 90). This is not a single rolled roofing material with a substrate, granules, and a release backing as claimed by Applicant. At the point of overlap there are^a total of three different roofing materials: a first layer of underlayment, a second overlapping layer of undelayment and a third sheet of roofing material (element 10).

The Office cannot make a consistent argument that the substrate is the same layer of substrate during the point of overlap. The overlapping layer of substrates discloses multiple substrates and cannot be read as disclosing one substrate. The Office also cannot maintain an argument that the roofing material is merely an aggregate of Simpson's multiple roofing materials. If Simpson were to combine the disclosed multiple roofing

materials, which Applicant does not concede one skilled in the art at the time of the invention would have done, the combination would not incorporate the overlapping of the multiple layers of underlayment since the overlap is a product of the joining the two separate underlayments. A combined continuous sheet of underlayement would have no need for overlap. Simpson discloses separate pieces of roofing material and does not provide a single substrate as claimed in Applicant's claim 21.

In addition, the applied roofing system as cited by the Office and disclosed by Simpson, Figures 10 and 11, would not include the release paper. The release paper 96 would be striped to expose the adhesive 94 to the roof surface 98 as the underlayment 90 is rolled along the eave. See Simpson column 5, lines 55-58. The citation to the complete applied roof of Simpson does not disclose a release backing as claimed by Applicant's claim 21. Further, the applied roofing system with multiple roofing materials, as cited by the Office, would not be rolled as a completed system into a roll of roofing material. Therefore the anticipation rejections previously submitted with regard to dependent claim 21 should not apply. Accordingly, Applicant respectfully requests reconsideration and withdrawal of

the claim rejection.

B. Claims 21-31

The Applicant respectfully submits that since claims 22-31 depend on independent claim 21, claims 22-31 contain all limitations of independent claim 21. Since independent claim 21 should be allowed, as argued herein, pending dependent claims 22-31 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 44

Independent claim 44 reads:

A roofing material comprising:

a substrate saturated with a first asphalt composition having an upper and a lower surface;

a first layer of a second asphalt composition contacting only a first portion of said upper surface of said substrate, wherein said first layer does not contact at least a first region of said upper surface disposed along at least a first edge of said substrate;

a second layer of an adhesive composition contacting only a second portion of said lower surface of said substrate wherein said second layer does not contact at least a second region of said lower surface disposed along said at least said first edge of said substrate;

granules contacting an outer surface of said first layer; and

a release backing disposed over a bottom surface of said second layer.

(Emphasis Added)

The Applicant respectfully submits that Simpson fails to disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Applicant's claim 44 recites, a rolled roofing material comprising: a substrate, a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. The Office references, Simpson disclosure of multiple roofing materials in Figures 10 and 11. Simpson's applied roofing system includes multiple layers of roofing material including one or more a sheets of roofing material (element 10) and as referenced by the Office two layers of underlayment (element 90). This is not a single roofing material with a substrate, a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. At the point of overlap there are total of three different roofing materials: a first layer of underlayment, a second overlapping layer of underlayment and the sheet of roofing material (element 10).

The Office cannot make a consistent argument that the substrate is the same layer of substrate during the point of

overlap. The overlapping layer of substrates discloses multiple substrates and cannot be read as disclosing one substrate. The Office also cannot maintain an argument that the roofing material is merely an aggregate of Simpson's multiple roofing materials. If Simpson were to combine the disclosed multiple roofing materials, which Applicant does not concede one skilled in the art at the time of the invention would have done, the combination would not incorporate the overlapping of the multiple layers of underlayment since the overlap is a product of the joining the two separate underlayments. A combined continuous sheet of underlayement would have no need for overlap. Simpson discloses separate pieces of roofing material and does not provide a single substrate as claimed in Applicant's claim 44.

In addition, the applied roofing system as cited by the Office and disclosed by Simpson, Figures 10 and 11, would not include the release paper. The release paper 96 would be striped to expose the adhesive 94 to the roof surface 98 as the underlayment 90 is rolled along the eave. See Simpson column 5, lines 55-58. The citation to the applied system of Simpson does not disclose a release backing as claimed by Applicant's claim 44.

Therefore the anticipation rejections previously submitted with

regard to dependent claim 44 should not apply. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

III. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

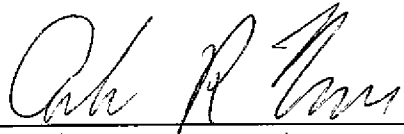
CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 21-31 and 44 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

In re: Thomas Zickell
Filed: July 3, 2001
Serial No.: 09/898,707
Page 17

Respectfully submitted,

Thomas Zickell

By 
Andrew R. Martin, Esquire
Registration No. 45,413
Attorney for Applicant(s)

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: 5-1-07